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09/865,229	05/25/2001	Donald R. Youell JR.	ACP 2-021	2603

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EXAMINER

DURAND, PAUL R

ART UNIT	PAPER NUMBER
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3721

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/865,229
Filing Date: May 25, 2001
Appellant(s): YOUELL ET AL.

Diane Burke
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/8/2006 appealing from the Office action
mailed 11/10/2005.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 1-5 and 24.

Claims 6-23 are withdrawn from consideration as not directed to the elected invention.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

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(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

3,784,004	Meyer	01-1974
4,611,456	Gillio-tos	09-1986
3,154,898	Engles	11-1964
3,618,755	Kean	11-1971
6,010,003	Wilkinson	01-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

Claims 1 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Meyer (US 3,784,004).

In regard to claim 1, Meyer discloses the invention as claimed including a paperboard 12, having a front and back, placing an automobile part 14, that is

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comprised of a structural part such as a bearing, on the front of the paperboard, leaving front areas exposed and shrink wrapping the part onto the paperboard with film 16 (see Figs. 1-3, C1,L12-20, C3,L49-61 and C5,30-52).

In regard to claims 1 and 24, Meyer inherently discloses the invention as claimed including protecting the contents not only from corrosion or the external atmosphere, but also from impact through the use of the base pad or substrate 12 and the film 16 itself. Additionally in claim 1, it is also an inherent property of a package to be shipped to an end user after it has been packaged.

Claim Rejections - 35 USC § 103

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer in view of Gillio-tos et al (US 4,611,456).

Meyer discloses the invention substantially as claimed including a paperboard back. What Meyer does not disclose is the backing being comprised of a laminate. However, Gillio-tos discloses that it is old and well known in the art to use a backing 1, that can be comprised of a laminate as a means of increasing product durability (see Figs. 8,9 and C3,L20-23). Therefore it would have been obvious to one having ordinary skill in the art to have provided the invention of Meyer with a laminate backing as taught by Gillio-tos for the purpose of increasing product durability.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer in view of Engles Jr. (US 3,154,898).

Meyer discloses the invention substantially as claimed except for specific mention of an automobile part being comprised of metal composite or glass. However, Engles teaches that it is old and well known in the art of skin packaging to provide a structural automobile part (i.e. a part having structure) 10, that is comprised of composite metal and porcelain, which is shrink wrapped to a backing 14, by film 16 for the purpose of protecting the product from damage during transport (see Figs. 1-3, C1, L15-18 and C2, L59-69). Therefore, it would have been obvious to one having ordinary skill in the art to have provided the invention of Meyer with the specific skin packaged structural part as taught by Engles for the purpose of protecting the product from damage during transport.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer and Engles Jr. as applied to claims 1 and 3 and in further view of Kean (US 3,618,755).

In regard to claim 4, the modified invention of Meyer discloses the invention substantially as claimed as applied to claims 1 and 3 above including a packaged article can be comprised of bearings, clutches or various automobile or mechanical parts, which in the broadest reasonable interpretation could include a so called "structural" part (see C5, L30-52). What the modified invention of Meyer does not explicitly disclose is an automobile part that is comprised of window glass, door panel, hood, fender or combinations thereof. However, Kean teaches that it is old and well known in the art of shrink packaging to package glass sheets 21, such as the type found in a window, which are packaged on a corrugated paperboard panel 22 and then shrink wrapped with envelope 35 for the purpose of protecting a product during shipping. Therefore, it would

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have been obvious to one having ordinary skill in the art to have provided the modified invention of Meyer with a packaged part comprised of window glass for the purpose of protecting a product during shipping.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer in view of Wilkinson (US 6,010,003).

Meyer discloses the invention substantially as claimed except for the method of placing the shrink-wrapped packages in a box or container. However, Wilkinson teaches that it is old and well known in the art to place an object "O" that has been shrink wrapped to a backing with wrap 172, in a container "C" for the purposes of protecting the item during shipping (See Figs. 16 and 17). Therefore, it would have been obvious to one having ordinary skill in the art to have provided the invention of Meyer with a shipping container as taught by Wilkinson for the purpose of protecting the items during shipping.

(10) Response to Argument

A. Examiner interpretation of the independent claim

During patent examination of the claims, the pending claims must be given their broadest reasonable interpretation consistent with the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005). See also MPEP § 2111. Moreover, while the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, *this is not the mode of claim interpretation to be applied during examination*. During examination, the claims must be

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interpreted as broadly as their terms reasonably allow. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004). See also MPEP § 2111.01.

Independent claim 1 recites:

Method for packaging an automobile part to decrease damage during shipment, which comprises the steps of:

- (a) providing a paperboard having a front and a back;
- (b) placing a structural automobile part on the front of said paperboard leaving exposed areas of said front of said paperboard; and
- (c) shrink-wrapping with plastic shrink wrap material said structural automobile part to said paperboard and said exposed areas of said front of said paperboard, wherein damage to said structural automobile part is decreased during shipping.

The claim preamble recites a method for packaging an automobile part, which in the broadest reasonable interpretation, consists of virtually any part to be utilized on or inside an automobile.

Step "a" of the claim provides a paperboard, which can consist of a board shaped object having a front and back and manufactured from a paper or paper based compound such as cellulose or corrugated cardboard.

Step "b" of the claim entails placing a structural automobile part on the front of the paperboard, while leaving exposed areas on the front. While this element now limits to the automobile part in the preamble to one of a structural nature, this can be broadly

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interpreted as a part having some sort of structure or shape to it. Moreover, the placement of the part onto the paperboard can occur anywhere on the front so long as there are exposed areas remaining. In other words, the part must not cover the entire area of the paperboard prior to and after shrink wrapping.

Step "c" of the claim entails shrink wrapping, with plastic shrink wrap, the structural automobile part to the paperboard, to include the exposed area on the front, wherein damage is prevented during shipping. This step is interpreted to provide a plastic, shrinkable, wrapping material, which is applied to the front of the paperboard to encase the part and exposed areas of the front of the paperboard. Moreover, while the claim does not positively set forth a shipping step or limitation, it is generally interpreted that some sort of damage to the part must be decreased or mitigated (as compared to what?) during shipment to an area located separately from the wrapping operation.

B. The rejection of claims 1 and 24 under 35 U.S.C. § 102(b) is proper and should be affirmed.

Appellant first argues on pages 10 and 11, that Meyer does not anticipate, nor render obvious a method for packaging and shipping a structural automobile part wherein damage to the part is decreased. For the reasons set forth in the rejection, Meyer anticipates every element of the claim and should be affirmed.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See also MPEP § 2131.

Meyer as disclosed in the rejection, above anticipates the elements set forth in the claim. Meyer discloses providing a paperboard substrate 12, which can be comprised of "conventional corrugated paperboard using fourdrinier kraft paper" (see column 3, lines 60-61), placing an object 14 on the front of the paperboard, which is preferably a food item, but can also be comprised of "metal products such as ... various automobile or mechanical parts." (see column 5, lines 39-41), leaving exposed areas on the front of the paperboard and shrink wrapping with shrink wrap material 16, the part and the exposed areas of the front of the paperboard. (see figures 1-3).

Appellant argues that Meyer does not disclose the use of a structural automobile part. However, Appellant has not specifically set forth a definition in the specification for the term structural that makes the plain meaning of the term inconsistent with it. Words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). See also MPEP § 2111.01. Page 4, lines 7-19, does give some examples "such as hoods, fenders and doors" or even "automobile glass", but these are examples and in no way impart a definition, or imply an inconsistency with the plain meaning of the term structural.

Additionally, the specification uses the terms "structural automobile part" and "automobile part" interchangeably. Page 4, lines 12 and 14, references a "structural automobile part", while page 1, lines 8 and 15, page 2, lines 6,8,9 and 31 and page 6, line 19, all reference an "automobile part". This suggests that "structural automobile part" and "automobile part" are synonymous.

Lastly, even assuming that the prior art of Meyer does not explicitly anticipate the reduction of damage limitation found in step "c", it is an inherent property of any package to reduce or lessen the amount of damage, whether slight or great, to an object by the fact that there is a barrier between the object and the environment. MPEP § 2112.02 clearly teaches that under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. Additionally, when the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process. *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986). In this instance, the package as taught by Meyer would provide some degree of tactile protection to the packaged object during normal operation through the utilization of the paperboard base and shrink wrapping.

Appellant further argues that Meyer is non-analogous art as it is applied to the 102(b) rejection. "Arguments that the alleged anticipatory prior art is 'non-analogous art' ... or not recognized as solving the problem solved by the claimed invention, are not 'germane' to a rejection under section 102." *Twin Disc, Inc. v. U.S.*, 231 USPQ 417, 424 (Cl. Ct. 1986). See also MPEP § 2133.05.

Though Meyer is primarily concerned about corrosion protection and appellants' invention is more concerned with tactile protection, Appellant is attacking an anticipation rejection with an obviousness argument. Meyer may be directed to an entirely different problem than the one addressed by the inventor, or may be from an entirely different

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field of endeavor than that of the claimed invention, but Meyer is still anticipatory if it explicitly or inherently discloses every limitation recited in the claims. MPEP § 2133.05. As Meyer anticipates every element of claims 1 and 24, the rejection is proper.

Appellant lastly argues on pages 13-15 that Meyer is again non-analogous art in view of the declarations submitted under 37 C.F.R. § 1.132. Moreover, Appellant argues on page 14, that the commercial success of the invention is grounds for the remand of the rejection under 102(b). For at least the reasons stated above, appellant is attacking an anticipation rejection with an obviousness argument.

"Affidavits or declarations, containing evidence of ... unexpected results, commercial success, ... must be considered by the examiner in determining the issue of *obviousness* for patentability under 35 U.S.C. 103." *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538, 218 USPQ 871, 879 (Fed. Cir. 1983). See also MPEP § 716.01(a). Moreover, "Evidence of secondary considerations, such as unexpected results or commercial success, is irrelevant to 35 U.S.C. § 102 rejections and thus cannot overcome a rejection so based." *In re Wiggins*, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973).

Meyer clearly anticipates, or in the alternative inherently discloses each and every element of the claims 1 and 24. Appellants' arguments of non-analogous art and the submission of affidavits under § 1.132 are inappropriate and irrelevant to an anticipation rejection under § 102(b). The rejection should be affirmed.

C. The rejection of claim 2 under 35 U.S.C. § 103(a) is proper and should be affirmed.

Appellant argues on pages 15 and 16, that it would have not been obvious to combine the teaching of Gillio-tos with the primary reference of Meyer since neither reference discloses the packaging of a structural automobile part. Appellant further argues that Gillio-tos does not even disclose the packaging an automobile part.

Appellee is aware that there are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) . See also MPEP § 2143.01.

In this instance, Meyer discloses the invention as claimed including the use of a paperboard to hold and object to be packaged. As per column 3, lines 60-61, and Appellants own admission in the specification on page 4, lines 30-31, the paperboard could be corrugated. While it is generally known that a corrugated product is comprised of a laminate of materials, the laminate limitation is implicit in Meyer.

The teaching of Gillio-tos was chosen to show Appellant that it is obvious to provide a shrink wrapping process and product with a backing comprised expressly of a laminate. While the preferred material is disclosed as polymers and it's variants (see column 3, lines 25-31), Gillio-tos more importantly discloses on column 3, lines 16-17, that "the single requisite is that it be a thermo formable material" and that the material can be comprised of "laminated multilayer materials as well" (see column 3, line 23). This suggests in Gillio-tos that the choice of material is not the overriding concern, but

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rather that the material more importantly has to have the ability to be formed utilizing heat.

Additionally, Appellant appears to be arguing against non-obviousness by attacking the Gillio-tos reference alone as not the combination of references as a whole. "One cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references." *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). See also MPEP § 2145(IV).

Appellant has not overcome the *prima facie* burden of obviousness as the Appellee has provided sufficient motivation to reject the claim under Meyer in view of Gillio-tos. The § 103(a) rejection of claim 2 should be affirmed.

D. The rejection of claim 3 under 35 U.S.C. § 103(a) is proper and should be affirmed.

Appellant argues on page 16, that it would not have been obvious to combine the teaching of Engles with the primary reference of Meyer, since Engles teaches away from the use of paperboard and instead utilizes a thermoformed foam backing.

Meyer discloses the invention as claimed including packaging an object, which may be comprised of "metal products such as ... various automobile or mechanical parts." (see column 5, lines 39-41). While Meyer is silent as to the type of material being comprised from a group consisting of metal, composite, glass or combinations thereof. The teaching of Engles was provided to show Appellant that it is well known to package an automobile part (a spark plug), comprised of metal and glass (ceramic).

While it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). See also MPEP §2145(X)(D)(2), the Appellant is looking at a single element of the combined invention to determine non-obviousness and not what the combination of the references teach as a whole. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). See also MPEP § 2143.01(VI). Both Meyer and Engles function in the same principle manner. Both utilize a packaging process which heat shrinks an object onto the front of a backing board and both leave areas exposed on the front for film adherence. For this reason the combination of Meyer and Engles is proper.

Lastly, Appellant argues that neither Meyer or Engles teach the method of packaging "large" automotive parts and as such, is arguing limitations which are not even present in the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). See also MPEP §2145(VI).

Appellant has not overcome the *prima facie* burden of obviousness as the Appellee has provided sufficient motivation to reject the claim under Meyer in view of Engles. The § 103(a) rejection of claim 3 should be affirmed.

E. The rejection of claim 4 under 35 U.S.C. § 103(a) is proper and should be affirmed.

Appellant argues on page 17, that it would have not been obvious to combine the teaching of Kean with the modified reference of Meyer and Engles, since Kean teaches away from the invention.

As discussed above, there are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” *In re Rouffet*, 149 F.3d at 1357. In this instance, Kean is well within the nature of the prior art and knowledge of person of ordinary skill in the art. Kean teaches the packaging an object such as a window glass 21, which is packaged onto a paperboard panel 22 and subsequently secured into an envelope 35, the envelope being comprised of a “heat sealable transparent plastic material of sheeting” (see figure 1 and column 2, lines 29-32).

Appellant has not overcome the *prima facie* burden of obviousness. The Appellee has provided sufficient motivation to reject the claim under the modified reference of Meyer in view of Kean. The § 103(a) rejection of claim 4 should be affirmed.

F. The rejection of claim 5 under 35 U.S.C. § 103(a) is proper and should be affirmed.

Appellant argues on page 17, that the combination of Meyer and Wilkinson is improper since the base reference of Meyer does not disclose the limitations as argued above in regard to claim 1.

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As stated above, there are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d at 1357.

In this instance, Meyer discloses the invention as claimed as applied to claim 1, and as argued previously above. The teaching of Wilkinson was chosen to show Appellant that it is old and well known to people having ordinary skill in the art to place an object, which has been shrink wrapped onto a backing into a container.

Appellant has not overcome the *prima facie* burden of obviousness. The Appellee has provided sufficient motivation to reject the claim under the reference of Meyer in view of Wilkinson. The § 103(a) rejection of claim 5 should be affirmed.

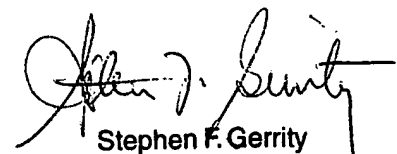
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

 10/23/06
Paul R. Durand


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Primary Examiner

Conferees:

Stephen Gerrity 

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